

ESTTA Tracking number: **ESTTA729280**

Filing date: **02/24/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223528
Party	Plaintiff Clariant Corporation
Correspondence Address	SEAN M SULLIVAN LEE SULLIVAN SHEA & SMITH LLP 224 N DESPLAINES ST, STE 250 CHICAGO, IL 60661 UNITED STATES sullivan@ls3ip.com, smith@ls3ip.com
Submission	Answer to Counterclaim
Filer's Name	Sean M. Sullivan
Filer's e-mail	sullivan@ls3ip.com
Signature	/Sean M. Sullivan/
Date	02/24/2016
Attachments	2016.02.24 Answer to Multisorb CC (FINAL).pdf(108791 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

CLARIANT CORPORATION	)	
	)	
	)	
Opposer,	)	Opposition No. 91223528
	)	
v.	)	Application Serial No. 86/569,259
	)	
MULTISORB TECHNOLOGIES, INC.	)	
	)	
Applicant.	)	

**CLARIANT’S ANSWER TO APPLICANT’S AMENDED COUNTERCLAIM**

Opposer Clariant Corporation (“Opposer” or “Clariant”) hereby submits its Answer to Applicant Multisorb Technologies, Inc.’s (“Applicant” or “Multisorb”) Amended Counterclaim to Cancel Registration as follows:

**APPLICANT’S AMENDED COUNTERCLAIM TO CANCEL REGISTRATION**

23. Applicant repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

**CLARIANT’S ANSWER:**

Opposer repeats and realleges each and every allegation contained in Paragraphs 1-22 of Clariant’s Notice of Opposition as if fully set forth herein.

24. Applicant hereby seeks cancellation of U.S. Trademark Registration No. 1,369,682 (“DESI PAK”) for all the goods listed therein, as to which Opposer claims actual use, namely, “PREPACKAGED DESICCANTS FOR USE IN CLOSED PACKAGES FOR MACHINE PARTS, ELECTRONIC COMPONENTS, SURGICAL INSTRUMENTS AND SUPPLIES, TOOLS, PHARMACEUTICALS, FOOD AND FILM,” all in International Class 001.

**CLARIANT’S ANSWER:**

Clariant admits that Paragraph 24 of Applicant’s Amended Counterclaim purports to seek cancellation of U.S. Trademark Registration No. 1,369,682 (“DESI PAK”) for all the goods listed therein, but Clariant denies that Applicant is entitled to any such cancellation or any other relief that Applicant is seeking in its Amended Counterclaim.

Clariant denies any remaining allegations set forth in Paragraph 24 of Applicant’s Amended Counterclaim.

**APPLICANT’S FIRST GROUND—ABANDONMENT**

25. Upon information and belief, Opposer failed to use the DESI PAK mark in commerce for at least three consecutive years, with an intention not to resume use, during the period of 2005 through 2013.

**CLARIANT’S ANSWER:**

Clariant denies each and every allegation set forth in Paragraph 25 of Applicant’s Amended Counterclaim.

26. Applicant’s information and believe [*sic*] is based upon Applicant’s communications with Opposer prior to Applicant filing a response and counterclaim. In those communications, Applicant told Opposer that it would voluntarily withdraw its application for the DESIPAX mark if Opposer could demonstrate continuous use of its DESI PAK mark for at least the last ten years.

**CLARIANT’S ANSWER:**

Clariant admits that Paragraph 26 of Applicant’s Amended Counterclaim purports to set forth the basis for Applicant’s abandonment allegation, but Clariant denies that Applicant’s abandonment allegation has any merit.

Clariant also admits that, during a telephone call on September 11, 2015, counsel for Applicant told counsel for Clariant that Applicant would voluntarily withdraw its application for

the DESIPAX mark if Clariant showed continuous use of its DESI PAK mark for the last ten years.

Clariant denies any remaining allegations set forth in Paragraph 26 of Applicant's Amended Counterclaim.

27. Opposer submitted marketing material to Applicant in the form of screenshots from the Internet Archive (Wayback Machine) website, but no proof of sales were provided, despite Applicant's request that at least some minimal evidence of actual sales in commerce of Opposer's DESI PAK mark be provided. Opposer did not and has not provided additional information or evidence of actual use of the DESI PAK mark in interstate commerce.

**CLARIANT'S ANSWER:**

Clariant admits that, on October 1, 2015, counsel for Clariant sent a letter to counsel for Applicant providing evidence of Clariant's continuous use of its DESI PAK mark in commerce since December 13, 1983. This evidence included Clariant's Affidavit of Continued Use and Incontestability under Sections 8 and 15 filed in 1991, Clariant's Affidavit of Continued Use and Application for Renewal under Sections 8 and 9 filed in 2005, screenshots of Clariant's (and its predecessor Süd-Chemie's) website from the Internet Archive (also referred to as the "Wayback Machine") for each of the years 2005-2014, a screenshot of Clariant's website for the year 2015, and a 2013 Clariant Product Sheet.

Clariant also admits that, on October 6, 2015, counsel for Clariant sent an email to counsel for Applicant explaining that a confidentiality agreement would need to be agreed to by the parties before Clariant would produce any confidential sales information to Applicant.

Clariant denies the remaining allegations set forth in Paragraph 27 of Applicant's Amended Counterclaim.

28. Specifically, on October 1, 2015, counsel for Clariant submitted screenshots of webpages from the website Internetarchive.com, known also as the "Wayback Machine". The

Internet Archive is an online “library” that takes snapshots of individual pages of a website of a particular moment in time. The dates of the webpages provided were March 19, 2005; April 28, 2006; October 27, 2007; December 4, 2008; May 9, 2009; April 12, 2010; April 24, 2011; April 12, 2012; August 3, 2013; July 1, 2014. They also submitted two product information sheets found on Clariant’s website, one from the Wayback Machine from 2013, the other a print screen from Clariant’s current website (as of October 2015).

**CLARIANT’S ANSWER:**

Clariant admits that, on October 1, 2015, counsel for Clariant provided counsel for Applicant screenshots of Clariant’s (and its predecessor Süd-Chemie’s) website from the Internet Archive (also referred to as the “Wayback Machine”) for each of the years 2005-2014 and that these screenshots are dated March 19, 2005; April 28, 2006; October 27, 2007; December 4, 2008; May 9, 2009; April 12, 2010; April 24, 2011; April 12, 2012; August 3, 2013; and July 1, 2014, respectively.

Clariant also admits that the Wayback Machine is a collection of archived data that the Internet Archive has compiled using software programs known as crawlers that surf the Web and store copies of web files, preserving those files as they existed at the point of time of capture.

Clariant also admits that, on October 1, 2015, counsel for Clariant provided counsel for Applicant a screenshot of Clariant’s website as of September 2015 as well as a 2013 Clariant Product Sheet.

Clariant denies the remaining allegations set forth in Paragraph 28 of Applicant’s Amended Counterclaim.

29. None of the above listed documents is evidence of any actual sale of a product bearing the DESI PAK trademark in the US or anywhere else. Neither do the documents show a website from which the product could be purchased (a requirement for a website to demonstrate use in commerce specifically required in TMEP 904(3)(i).) Instead, the documents only list a phone number and email address to call for more information or samples. At best the websites are advertising or promotional material, and not evidence of use on product. Because the website screenshots and product information sheets provided to Applicant by Opposer do not show any use of the mark in commerce, Opposer formed a belief that Applicant was not using the mark).

**CLARIANT’S ANSWER:**

Clariant denies each and every allegation set forth in Paragraph 29 of Applicant’s Amended Counterclaim.

30. On October 2, 2015, counsel for Applicant informed counsel for Opposer that Applicant would need additional information and actual proof of sales in order for Opposer to withdraw its application. Opposer never provided the additional requested evidence.

**CLARIANT’S ANSWER:**

Clariant admits that, on October 2, 2015, after counsel for Clariant provided counsel for Applicant evidence of Clariant’s continuous use of its DESI PAK mark in commerce since December 13, 1983, Applicant sent an email to counsel for Clariant requesting additional information that Applicant characterized as “real evidence of continuous use in commerce.”

Clariant also admits that, on October 6, 2015, in response to Applicant’s email of October 2, 2015, counsel for Clariant sent an email to counsel for Applicant explaining that a confidentiality agreement would need to be agreed to by the parties before Clariant would produce any confidential sales information to Applicant. Clariant further admits that it has not provided any confidential sales information to Applicant.

Clariant denies any remaining allegations set forth in Paragraph 30 of Applicant’s Amended Counterclaim.

31. Opposer has also relied upon “declarations of continued use” under section 8 (filed in 1991, 2005, and 2015) and a declaration under section 15 (filed in 1991) as evidence of continued use. Applicant does not dispute that Opposer filed declarations on these dates. The evidence provided by these declarations alleges continuous use from 1985 to 1991 (via the 7 section 15 declaration), but only two instances of use from 1991 to 2015 because the most recent declarations under Section 8 only allege use as of the dates of the declarations (2005 and 2015), and not continuous use between 1991 and 2015. As such, Applicant does not agree that these declarations of use allege, let alone demonstrate, continuous use of the mark in commerce over a period of time that would eliminate the possibility that Opposer ceased using the mark for at least three years between 1991 and 2005 or between 2005 and 2015. The declarations do not change.

**CLARIANT’S ANSWER:**

Clariant admits that, on October 1, 2015, counsel for Clariant sent a letter to counsel for Applicant providing evidence of Clariant’s continuous use of its DESI PAK mark in commerce since December 13, 1983. This evidence included, *inter alia*, Clariant’s Affidavit of Continued Use and Incontestability under Sections 8 and 15 filed in 1991 and Clariant’s Affidavit of Continued Use and Application for Renewal under Sections 8 and 9 filed in 2005.

Clariant also admits that, on December 11, 2015, Clariant submitted its Motion to Dismiss Multisorb’s Counterclaim, which explained that “Clariant’s continued use of its DESI PAK mark is evidenced by, *inter alia*, Clariant’s Declarations of Use (which include specimens) submitted under Section 8 of the Trademark Act, 15 U.S.C. § 1058, on January 22, 1991, March 22, 2005, and most recently October 21, 2015.”

Clariant also admits that Paragraph 31 of Applicant’s Amended Counterclaim purports to set forth the basis for Applicant’s abandonment allegation, but Clariant denies that Applicant’s abandonment allegation has any merit.

Clariant denies the remaining allegations set forth in Paragraph 31 of Applicant’s Amended Counterclaim.

32. Based upon Opposer’s failure to provide Applicant with proof of continuous use of its DESI PAK mark in commerce sufficient to eliminate the possibility of abandonment, it is Applicant’s opinion and belief that Opposer ceased using the DESI PAK mark, with an intention not to resume use, for at least one three-year period between 2005 and 2015.

**CLARIANT’S ANSWER:**

Clariant denies each and every allegation set forth in Paragraph 32 of Applicant’s Amended Counterclaim.

33. Opposer has therefore abandoned the DESI PAK mark by discontinuing use of the mark for each of the goods listed therein, with an intention not to resume use, and accordingly, Registration No. 1,369,682 should be cancelled.

**CLARIANT'S ANSWER:**

Clariant denies each and every allegation set forth in Paragraph 33 of Applicant's Amended Counterclaim.

Clariant also denies that Applicant is entitled to the relief sought in Paragraph 33 of Applicant's Amended Counterclaim.

**APPLICANT'S PRAYER FOR RELIEF**

WHEREFORE, Applicant requests that Registration No. 1,369,682, be cancelled, the Opposition be dismissed and that Serial No. 86/569,259 be allowed to register.

**CLARIANT'S ANSWER:**

The allegations in Applicant's unnumbered paragraph requesting relief consist of legal conclusions and a prayer to which no response is required. To the extent a response is deemed required, however, Clariant denies that Applicant is entitled to the relief sought.

**CLARIANT'S AFFIRMATIVE DEFENSES**

Without prejudice to the denials set forth above, without admitting any of Applicant's allegations not otherwise admitted, and without undertaking any of the burdens imposed by law on Applicant, Clariant asserts the following affirmative defenses to Applicant's Amended Counterclaim, and expressly reserves the right to amend its answer to add additional affirmative defenses as may become available or appear proper after a reasonable opportunity for appropriate discovery.

### **CLARIANT'S FIRST AFFIRMATIVE DEFENSE**

For at least the reasons explained in Clariant's Motion to Dismiss Multisorb's Counterclaim (filed December 11, 2015) and Clariant's Reply in Support of Its Motion to Dismiss Multisorb's Counterclaim (filed January 6, 2016), Applicant's Amended Counterclaim still fails to state a claim upon which relief can be granted.

### **CLARIANT'S SECOND AFFIRMATIVE DEFENSE**

Applicant's Amended Counterclaim is barred, in whole or in part, by the equitable doctrines of unclean hands, laches, estoppel, and/or acquiescence.

WHEREFORE, Clariant requests that the Board:

- A. Deny the relief sought in Applicant's Amended Counterclaim;
- B. Dismiss Applicant's Amended Counterclaim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure;
- C. Sustain Clariant's opposition against Application Serial No. 86/569,259; and
- D. Grant Clariant any other relief that the Board deems appropriate.

Date: February 24, 2016

Respectfully submitted,

/Sean M. Sullivan Reg. No. 40,191/

Sean M. Sullivan

Sean M. Sullivan (USPTO Reg. No. 40,191)  
John Dan Smith (USPTO Reg. No. 66,743)  
Lee Sullivan Shea & Smith LLP  
224 N Desplaines St, Suite 250  
Chicago, Illinois 60661  
Tel: (312) 754-9602  
*sullivan@ls3ip.com*  
*smith@ls3ip.com*

*Attorneys for Opposer Clariant Corporation*

## CERTIFICATE OF SERVICE

I hereby certify that on February 24, 2016, a true and complete copy of the foregoing CLARIANT'S ANSWER TO APPLICANT'S AMENDED COUNTERCLAIM was served on Applicant's Attorney of Record for Application Serial No. 86/569,259 by sending via email a copy to:

Rhett V. Barney  
Lee & Hayes, PLLC  
601 West Riverside, Suite 1400  
Spokane, WA 99201  
Tel: (509) 944-4642  
*rhettb@leehayes.com*

Date: February 24, 2016

/Sean M. Sullivan Reg. No. 40,191/  
Sean M. Sullivan

Sean M. Sullivan (USPTO Reg. No. 40,191)  
John Dan Smith (USPTO Reg. No. 66,743)  
Lee Sullivan Shea & Smith LLP  
224 N Desplaines St, Suite 250  
Chicago, Illinois 60661  
Tel: (312) 754-9602  
*sullivan@ls3ip.com*  
*smith@ls3ip.com*

*Attorneys for Opposer Clariant Corporation*